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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,208	07/29/2003	Darin L. Dotson	5662	1121

7590

04/05/2006

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P.O. Box 1927
Spartanburg, SC 29304

EXAMINER

SANDERS, KRIELLION ANTIONETTE

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/632,208

Applicant(s)

DOTSON ET AL.

Examiner

Kriellion A. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Certain related applications and patents have come to the attention of the examiner. The following rejections include these newly found applications and patents.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-9 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for metal salts of formula (1) wherein the alkyl moieties represented by substituents $R_1 - R_9$ may be combined to form a carbocyclic group of up to six carbons, does not reasonably provide enablement for metal salts of formula (1) wherein the alkyl moieties represented by substituents $R_1 - R_9$ may be linked together to form one or more additional carbon containing rings. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference

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claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-12 of U.S. Patent No. 6794433. Although the conflicting claims are not identical, they are not patentably distinct from each other because each invention is directed to thermoplastic polymer articles such as polypropylene or polyester, containing a metal salt of formula (1), wherein the formula (1) salts have common structures. Applicant is advised that the claims of the present application are not true process claims, but a method of combining a thermoplastic of the patented invention with a compound of formula (1) of the invention would be obvious to the ordinary practitioner of this art.

3. Claims 1-9 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-12 of U.S. Patent No. 6559971. Although the conflicting claims are not identical, they are not patentably distinct from each other because each invention is directed to thermoplastic polymer articles such as polypropylene or polyester, containing a metal salt of formula (1), wherein the formula (1) salts have common structures. Applicant is advised that the claims of the present application are not true process claims, but a

method of combining a thermoplastic of the patented invention with a compound of formula (1) of the invention would be obvious to the ordinary practitioner of this art.

4. Claims 1-9 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6534574. Although the conflicting claims are not identical, they are not patentably distinct from each other because each invention is directed to thermoplastic polymer articles such as polypropylene or polyester, containing a metal salt of formula (1), wherein the formula (1) salts have common structures. Applicant is advised that the claims of the present application are not true process claims, but a method of combining a thermoplastic of the patented invention with a compound of formula (1) of the invention would be obvious to the ordinary practitioner of this art.

5. Claims 1-9 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6465551. Although the conflicting claims are not identical, they are not patentably distinct from each other because each invention is directed to thermoplastic polymer articles such as polypropylene or polyester, containing a metal salt of formula (1), wherein the formula (1) salts have common structures. Applicant is advised that the claims of the present application are not true process claims, but a method of combining a thermoplastic of the patented invention with a compound of formula (1) of the invention would be obvious to the ordinary practitioner of this art.

6. Claims 1-9 and 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6703434, claims 1-11 of U.S. Patent No. 6642290, claims 1-17 of U.S. Patent No. 6534574 and claims 1-11 and 16-18 of U.S. Patent No. 6562890.

7. Although the conflicting claims are not identical, they are not patentably distinct from each other because each invention is directed to thermoplastic polymer articles such as polypropylene or polyester, containing a metal salt of formula (1), wherein the formula (1) salts have common structures. Applicant is advised that the claims of the present application are not true process claims, but a method of combining a thermoplastic of the patented invention with a compound of formula (1) of the invention would be obvious to the ordinary practitioner of this art.

8. Claims 1-9 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-12 of copending application 10/632208 and 10/008206; claims 5-11 of copending application 10/172338; and claims 1-18 of copending application 11/103384. Although the conflicting claims are not identical, they are not patentably distinct from each other because each invention is directed to thermoplastic polymer articles such as polypropylene or polyester, containing a metal salt of formula (1), wherein the formula (1) salts have common structures, or the claims are drawn to methods of preparing the thermoplastics. Applicant is advised that the claims of the present application are not true process claims, but a method of combining a thermoplastic of the copending inventions with a compound of formula (1) of the invention would be obvious to the ordinary practitioner of this art in view of the teachings of the references.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claim Rejections - 35 USC § 103

10. Claims 1-9 and 11 are rejected under 35 U.S.C. 102(f or g) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6703434, U.S. Patent No. 6642290, U.S. Patent No. 6534574 and U.S. Patent No. 6562890.

11. Claims 1-9 and 11 are directed to an invention not patentably distinct from claims 1-6 of commonly assigned U.S. Patent No. 6703434, claims 1-11 of commonly assigned U.S. Patent No. 6642290, claims 1-17 of commonly assigned U.S. Patent No. 6534574 and claims 1-11 and 16-18 of commonly assigned U.S. Patent No. 6562890 as described above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patents No. 6703434, No. 6642290, No. 6534574 and No. 6562890, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a)


if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kriellion A. Sanders
Primary Examiner
Art Unit 1714

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